

REMARKS

Claims 1-20 are pending in the application. Claims 1-20 were subject to the Requirement for Restriction.

Restriction Requirement

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §§ 121 and 372:

- I. Claims 1-4, 7, 11-15, and 17-20, allegedly drawn to a cassette construct for preparing an inverted repeat sequence, and to plasmid, expression vectors, and host cells thereof.
- II. Claims 5, 6, 8-10, and 16, allegedly drawn to a method for preparing an amplification product comprising an inverted repeat sequence of a target sequence.

Election with Traverse

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I as "cassette construct for preparing an inverted repeat sequence" and "plasmid, expression vectors, and host cells thereof," with *traverse*. Applicants submit that at least claims 1-4, 7, 11-15, and 17-20 read on the elected invention.

Traverse

Notwithstanding the election of the invention set forth in Group I as “cassette construct for preparing an inverted repeat sequence” and “plasmid, expression vectors, and host cells thereof” in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner’s requirement for restriction.

The Examiner has stated that the groups of inventions set forth in the Restriction Requirement do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding special technical feature. In particular, the Office states that the technical feature shared in common by the groups is a cassette construct comprising an adaptor sequence, a spacer sequence, an inverted sequence of the adaptor sequence, and a target sequence bound thereto at either or both ends. The Requirement for Restriction further asserts that Brummel et al. (*The Plant Journal* 33:793-800, 2003; hereinafter BRUMMEL) teaches an inverted repeat construct comprising a spacer sequence flanked by inverted repeats of the 3’ untranslated region of the *nos* gene, and at one end, the PG transgene.

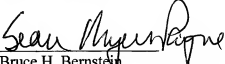
In response, Applicants submit that the claims encompass a special technical feature which defines a contribution over BRUMMEL. However, even if the Examiner’s characterization of Groups I-II were to be considered correct, Applicants respectfully request that the inventions defined in claims 1-20 be examined in the instant application, pursuant to the guidelines set forth in M.P.E.P. § 803. That is, the Examiner is respectfully requested to reconsider the requirement and find that there would not appear to be a “serious burden” on the Patent and Trademark Office in examining claims directed to the non-elected invention.

In particular, it would appear that a search for the inventions identified by the Examiner would significantly overlap. That is, if the Examiner were to perform a search for the invention of Group I, there would not appear to be a serious burden in continuing the examination of Group II. Furthermore, the Examiner has not stated that examination of all the claims would pose a burden, much less set forth any reasons why examination of all the restricted groups would be burdensome. For this reason, and consistent with the Office policy as set forth in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the Requirement for Restriction.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the Requirement for Restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application, for which Applicants have timely paid appropriate claim fees.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
Taku DEMURA et al.


Bruce H. Bernstein
Reg. No. 29,027 42,920

April 21, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191